

REMARKS

Status of the Claims

Claims 1, 2, 5-28, 32, 34-38, and 40-43 are pending in this application. Claims 29 and 30 have been canceled. No claims have been added or amended. Applicant submits the following arguments and Declaration under 37 CFR 1.131 in support of the allowability of the claims.

Rejection under 35 USC 112, first paragraph

The Examiner rejects claims 29 and 30 as not enabled for separating products on a TLC plate by electrophoresis without any modification to the TLC plate, such as attaching electrodes. Applicants traverse the rejection and respectfully request the withdrawal thereof. Applicant cancels claims 29 and 30. Thus, this rejection should be withdrawn.

Rejections under 35 USC 103(a)

The Examiner rejects claims 1, 2, 5-12, 15-30, 33-36 and 42-43 as obvious over Mehta et al. USP 6,306,590 (Mehta '590) in view of Frank. The Examiner also rejects claims 13 and 14 as obvious over Mehta '590 in view of Frank and Hudak USP 6,034,361. Claims 37 and 38 are also rejected as obvious over Mehta '590 in view of Frank and Bataillard USP 5,482,372. Claims 40 and 41 are also rejected

as obvious over Mehta '590 in view of Frank and DE 3,701,833. Applicant traverses all of the rejections and respectfully requests the withdrawal thereof.

Applicant submits the attached Declaration under 37 CFR 1.131 to antedate Mehta '590. Mehta '590 is prior art under §102(e) with an issue date of October 23, 2001 and filing date of June 8, 1998. Applicant submits that the attached Declaration under 37 CFR 1.131 shows that Applicant was in possession of the subject matter of the invention prior to the 102(e) date of Mehta '590.

Pursuant to 37 CFR 1.131, an Applicant may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the prior art. In order to effectively antedate Mehta '590, Applicant need only show prior invention of all that Mehta '590 teaches that corresponds to the claimed subject matter.

Applicant submits that Mehta '590 generally discloses a "multiphasic microfluidic apparatus" where synthesis and separation of the components occur in separate, albeit communicating compartments. The components are typically made or purified in the first phase and separated in the second phase. Mehta '590 has separation micro-channels that are filled with a gel. The micro-channels run both horizontally and vertically in the apparatus. However, the biological or chemical reagents tested in Mehta '590

do not move on the stationary phase in two-dimensions. Instead, the reagents in Mehta '590 simply follow the path of the micro-channel. At best, Mehta '590 discloses gel electrophoresis, which is conducted in a one-dimensional phase.

Mehta '590 fails to disclose screening of the products on the same bulk phase involving biological or biochemical methods as in the present invention. This has also been confirmed by the Examiner in the Office Action dated January 28, 2004, page 4, third full paragraph. As such, Applicant submits that to antedate Mehta '590, all that Applicant needs to show is prior invention of the synthesis and separation steps, steps (a) and (b) of claim 1, on the same bulk.

Applicant submits the attached Declaration under 37 CFR 1.131 with Exhibit A (laboratory notebook pages) to show prior invention of the subject matter of the claims that is disclosed in Mehta '590. The Declaration shows that Dr. Williams was working on the subject matter of the present invention at least as early as April 24, 1998 and that he had invented the synthesis and separation steps at least as early as May 12, 1998. Dr. Williams states that the final screening step did not occur until a later date. Exhibit A supports Dr. Williams assertions in the Declaration.

As such, Applicant submits that all obviousness rejections involving Mehta '590 should be withdrawn, as Mehta '590 is not

prior art to the present invention with the filing of the Declaration under 1.131 showing prior invention.

Conclusion

For the foregoing reasons, Applicant submits that the present invention is patentable over Mehta '590 as Mehta '590 is not prior art; thus, the claims should be allowed.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Kecia J. Reynolds (Reg. No. 47,021) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) respectfully petition(s) for a two (2) months extension of time for filing a reply in connection with the present application, and the required fee of \$420.00 is attached hereto.

Appl. No. 09/680,471

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachment: Declaration under 37 C.F.R. § 1.131 with Exhibit A

(Rev. 09/30/03)